Paper No. 38

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte RONALD E. PLEASANT

Appeal No. 1998-0256
Application No. 08/395,768

ON BRIEF

Before COHEN, FRANKFORT, and STAAB, Administrative Patent Judges.

COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 28 through 39. Claims 10 through 27 stand allowed. These claims constitute all of the claims remaining in the application.

Appellant's invention pertains to an improvement in a mold insert. A basic understanding of the invention can be derived from a reading of exemplary claim 28, a copy of which appears in the APPENDIX to the brief filed December 30, 1996 (Paper No. 34).

The following rejection is the sole rejection before us for review.

Claims 28 through 39 stand rejected under 35 U.S.C. § 112, first paragraph, as being based upon a specification which lacks descriptive support for the claimed invention.

The full text of the examiner's rejection and response to the argument presented by appellant appears in the answer (Paper No. 35), while the complete statement of appellant's argument can be found in the brief of December 30, 1996 (Paper No. 34).

OPINION

In reaching our conclusion on the description requirement issue raised in this appeal, this panel of the board has carefully considered appellant's specification and claim 28,[1]

[1] We direct our attention exclusively to the content of independent claim 28 since appellant indicates that the claims stand or fall together (brief, page 6).

and the respective viewpoints of appellant and the examiner. As a consequence of our review, we make the determination which follows.

We sustain the examiner's rejection of the claims on appeal for the reasons articulated, infra.

As our review Court stated in In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983):

> The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claim subject matter, rather than the presence or absence of literal support in the specification for the claimed language. The content of the drawings may also be considered in determining compliance with the written description requirement. (citations omitted)

Of course, a claimed invention does not necessarily have to be expressed in ***ipsis verbus*** in order to satisfy the description requirement. See In re Wertheim, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976)). However, it must also be kept in mind that the fact one skilled in the art might realize from reading a disclosure that something is possible is not a

sufficient indication to that person that the something is a part of an appellant's disclosure. See In re Barker, 559 F.2d 588, 593, 194 USPQ 490, 474 (CCPA 1977), cert. denied, 434 U.S. 1064 (1978). Precisely how close the original description must come to comply with the description requirement must be determined on a case-by-case basis. See Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991).

Our starting point is appellant’s original disclosure, considered in its entirety.

Considering the background of the invention, a clearly apparent objective of appellant’s disclosed invention is to insure that a barrier dam assembly (dam) will not, during use, slide or otherwise move around in a liquid conduit groove or work loose since there is a danger that a loose dam would fly away and cause injury to a lathe operator (specification, page 3, lines 4 through 12, page 4, lines 11 through 16, and page 14, lines 1 through 6 and lines 12 through 16).

Throughout the entirety of the specification, the reference is continuously to plural components as regards "locking members" such as "screws or pins" movable in "bores" in the dam with the clamping of the dam to the "surfaces" of a liquid conduit groove being accomplished by the engagement of "locking members" with inwardly-facing "surfaces" of "recesses" or "undercuts" in the "sidewalls" of the liquid conduit groove (for example, page 4, line 20 to page 5, line 13). The specification (page 5, lines 10 through 13) clearly sets forth that "clamping" of the dam in the liquid conduit groove is "by the use of locking members that extend through bores in the dam body member into engagement with inwardly-facing surfaces of the undercuts." The specification (page 6, lines 17 through 20) further explains that the leading ends of the clamping (locking) members tend to "gouge into the undercut surfaces." As additionally discussed in the specification (page 13, line 21 to page 14, line 16), as the screws are driven, the dam body is "effectively wedged" with increasing "clamping forces" such that the dam assembly is "securely locked" in the liquid conduit groove and "will not

slide about or work loose." As additionally described in the specification (page 14),

> The combined actions of the clamping forces described above applied to the dam body member 50 and the frictional forces between the interengaged locking screws 66 and undercut surfaces 42 cause the dam assembly 14 [to] be reliably, securely and tightly clamped within the liquid conduit groove 34.

As to the "preferred embodiment" of the invention (specification, page 7) appellant addresses "short locking screws" mounted within tapped "bores" with the screws being advanced into interfering engagement with inwardly facing "undercut surfaces" (Fig. 7). As a "modification" (specification, pages 7 and page 8, and pages 16 and 17), appellant describes short locking "pins" to be driven through dam member "bores" into interfering engagement with inwardly-facing "undercut surfaces" (Fig. 8). In the specification (page 17), relative to both embodiments (Figs. 7 and 8), appellant expressly indicates that a simple tool such as a screw driver or punch used to engage the exposed "heads" of the locking "screws or pins" is "all that is needed to effectuate the clamping of the dam assembly in place."

At this point, we turn our attention to the content of claim 28. This independent claim requires a mold insert comprising a solid metal body having a circumferentially-extending, outwardly-open, liquid conduit groove formed therein with an improvement wherein the groove has mutually confronting side walls, "one of which is provided with an undercut having an imperforate, sloping surface facing inwardly of the insert" for clamping engagement by "a locking element" for mounting a liquid barrier dam assembly in the groove.

Like the examiner, we conclude that appellant’s originally filed underlying disclosure, read as a whole, fails to reasonably convey to one skilled in the art that appellant had possession of the later claimed subject matter of claim 28.

It is quite clear to us that the import of appellant’s teaching, personified by the preferred and modified embodiments of Figs. 7 and 8, respectively, is that the objective of securely installing a liquid dam or barrier

assembly is achieved by an undercut in each of the confronting sidewalls of the groove intended for gouging engagement by locking screws or pins to insure that the dam during use will not slide or otherwise move around or become loose to avoid the danger that a loose dam would fly away from a rotating insert and cause injury to a lathe operator. Thus, appellant teaches the solution to the problem of a dam flying off a rotating insert and causing injury is to provide an undercut in each of the walls of the groove for engagement by locking members (screws or pins). Simply stated, appellant's specification offers no suggestion whatsoever that an undercut provided in one sidewall of the groove, when engaged by a screw or pin, would so secure a dam that the problem of the dam flying off a rotating insert and causing injury would be solved thereby.

Clearly, appellant's disclosure can fairly be viewed as a restricted or narrow disclosure. It offers a preferred embodiment (Fig. 7) to solve the noted dam securement problem that requires an undercut in each of the two sidewalls of the

conduit groove for engagement by locking screws. Further, it suggests an alternative arrangement for solving the problem (Fig. 8) wherein an undercut in each of the two sidewalls of the conduit groove is intended to be engaged by pins. As we see it, one skilled in the art would be informed by appellant's disclosure that an undercut in each of the two sidewalls of a conduit groove is needed to insure that a dam is secured in place and won't fly away and cause injury. The provision of an undercut in each sidewall of the conduit groove is the only possible solution offered by appellant in the specification. No variation is even suggested as to other than an undercut in each of the sidewalls of the conduit groove. Thus, this panel of the board finds it reasonable to say that the inclusion of an undercut in each of the sidewalls of a conduit groove for engagement by locking members is an essential structural attribute of appellant's invention, necessary to achieve the objective of a secure dam that won't fly away and cause injury.

It is appreciated that appellant seeks broad claim 28, in particular, in order to readily deter those who otherwise

avoid infringement (brief, page 14). However, claims can be no broader than a supporting disclosure. For the reasons set forth above, appellant's narrow disclosure limits claim breadth. See Gentry Gallery v. Berkline Corp., 134 F.3d 1473, 1479, 45 USPQ2d 1498, 1503 (Fed. Cir. 1998). Broad claim 28 is simply not descriptively supported by the original specification, and the rejection thereof under 35 U.S.C. § 112, first paragraph, is clearly sound.

The argument advanced by appellant in the brief (pages 6 through 14) does not persuade us that the examiner erred in rejecting the claims on appeal under 35 U.S.C. § 112, first paragraph. Contrary to the view advocated that one skilled in the art would clearly recognize that appellant invented what is claimed (brief, pages 9 through 11 and 13), we explained and gave a reasonable basis above why this would certainly not be the case. That one locking element (undercut) may be sufficient (brief, page 11), as argued, is simply not determinative of the description requirement issue in this appeal, as the Barker case, supra, indicates.

In summary, this panel of the board has affirmed the rejection of claims 28 through 39 under 35 U.S.C. § 112, first paragraph.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

IRWIN CHARLES COHEN Administrative Patent Judge	)	
CHARLES E. FRANKFORT Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
LAWRENCE J. STAAB Administrative Patent Judge	)	

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APPEAL NO. 1998-0256 - JUDGE COHEN

APPLICATION NO. 08/395,768

APJ COHEN

APJ STAAB

APJ FRANKFORT

DECISION:

Prepared By:

DRAFT TYPED: 26 Apr 02

FINAL TYPED: